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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,794	06/16/2000	Yoshihito Mizuta	2000 0757A	9888

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Wenderoth Lind & Ponack LLP  
Suite 800  
2033 K Street NW  
Washington, DC 20006

EXAMINER

CROCKFORD, KIRSTEN ANNE

ART UNIT	PAPER NUMBER
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1762

11

DATE MAILED: 06/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/594,794

Applicant(s)

MIZUTA, YOSHIHITO

Examiner

Kirsten Crockford

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) 29,34,39,41,43 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28, 30-33, 35-38, 40, 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Newly submitted claims 29, 34, 38, 41, 43, and 44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, i.e., it can be made by the process of U.S Patent No. 6,214,154 B1 -- by alternatively masking and transferring a pattern to first and second longitudinal portions of a loop shaped workpiece.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29, 34, 38, 41, 43, and 44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Amendment/Arguments***

2. Applicant's arguments filed April 24, 2002 have been fully considered but they are not persuasive. The new claims are rejected under 35 USC 112, 2<sup>nd</sup> paragraph for reasons set forth in the prior Office action and expanded upon in the paragraphs below. Additionally, the prior art rejections are maintained as set forth below.

### *Claim Objections*

3. Claim 23 is objected to because of the following informalities: In claim 23, lines 19-20, the Examiner suggests replacing “transferring” with --moving--. While page 11 of the specification teaches that this transferring step is defined as moving, it is the Examiner’s position that the term “transferring” is easily confused with the step of “transferring” the printed transfer pattern film onto the workpiece. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23-28, 30-33, 35-38, 40, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 12, 13, and 16 of claim 23, the Examiner maintains that the use of the terms “longitudinal direction” and “thickness direction” renders the claim vague and indefinite. Applicant responded to Applicant’s rejection by stating that the longitudinal direction is defined in the specification and reflected in the new claims, specifically that the longitudinal direction is the direction of extent of the workpiece. It is noted that page 8 the specification teaches that the longitudinal direction of a closed loop-like workpiece, such as a circle or steering wheel, is the circumferential direction. The specification and claims define the thickness direction as the direction perpendicular to the longitudinal direction. These definitions are confusing because,

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looking at a circle (such as a steering wheel), the longitudinal/circumferential direction changes with each point around the circle, similar to the way that a tangent to a circle changes at each point around the circle. Further, it is the Examiner's position that for a given point on a circle, the longitudinal/circumferential direction must be the line that forms a tangent with the circle (because at each point the tangent line is direction of the circumference at only that point). Therefore, the thickness direction must be the direction normal or perpendicular to the tangent of the circle/steering wheel.

Looking at the claims, if the cross section is defined as the plane of the surface of the transfer liquid at a transfer initiating site (as set forth in the claims), and it is assumed that the thickness direction is the line perpendicular to the tangent at each point (thus relating to the direction of the "thickness" of a steering wheel around its circumference), and the cross section is in the thickness direction, then it is the Examiner's position that the plane of the surface of the transfer liquid must be perpendicular to a tangent of the circle, or steering wheel. The *only* position where it is possible for the plane of the surface of the transfer liquid (which must be horizontal) to also be the same direction as a line perpendicular to a tangent of the circle would occur when a circular workpiece/steering wheel is immersed halfway (depth-wise) in the transfer liquid. The Examiner requests clarification that this is what is intended to be claimed. If so, it is noted that Figures 1, 6A, 6B, 7A, 7B, 8A, and 8B illustrate embodiments contrary to this assumption. The listed Figures each illustrate immersion of the workpiece to a level less than half the diameter of the steering wheel workpiece. The specification does not appear to clear up the confusion.

Alternatively, the Examiner has attempted to interpret the claims in another way. Looking at Figure 7B, the Examiner has taken the position that perhaps the longitudinal direction is meant to be defined as the direction of line R. While this is not a “circumferential” direction, it is the plane in which the circumference of the steering wheel (if flat) lies; R is defined as the “loop surface” on pages 8 and 12 of the specification. In this case, the thickness direction would be similar to line N, as N is perpendicular to R. The *only* position where it is possible for the plane of the surface of the transfer liquid to be in the same line/plane/direction as line N (thickness direction, as set forth in the claims) is when the steering wheel is solely in a vertical position. This clearly contradicts Figures 6A, 6B, 7A, 7B, 8A, and 8B and some dependent claims which illustrate or require that the steering wheel is at an angle. Clarification as to what is required by the claims is requested.

Also in claim 23, line 11, the term “substantially” is vague and indefinite in light of the above discussion because it is not clear what the metes and bounds of a particular direction would be when considering the phrase “substantially in a thickness direction.”

For purposes of examination, the Examiner has interpreted independent claim 23 as requiring either immersion of half the workpiece in the transfer liquid or immersion where the workpiece is required to be only in a vertical position.

Claims 26, 31, and 35-37 are vague and indefinite because they appear to be contrary to the limitations required by claim 23 as discussed above, since the claims require a deflection angle or immersion attitude which is not possible with one or both of the scenarios discussed above. For this reason, claims 26, 31, and 35-37 are also not rejected over prior art.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-005981 A.

JP '981 is applied for the same reasons set forth in the prior Office action. While the Examiner has considered Applicant's arguments regarding the JP '981 reference, it is the Examiner's position that the reference of JP '981 still meets the limitation of claim 23 as claim 23 has been interpreted above. It is noted that JP '981 illustrates that the steering wheel workpiece is immersed in a vertical position.

***Claim Rejections - 35 USC § 103***

8. Claims 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 61-005981 A.

JP '981 is applied for the same reasons set forth in the prior Office action.

9. Claims 24-25, 28, 30, 32-33, 40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 61-005981 A as applied to claims 23, 27, and 39 above, and further in view of Watanabe et al. (US 6,022,438).

JP '981 and Watanabe et al. are applied for the same reasons set forth in the prior Office action.

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10. Claims 23-25, 28, 30, 33, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 6,022,438).

Watanabe et al. is applied for the same reasons set forth in the prior Office action. In light of the 35 USC 112 rejections set forth above in response to Applicant's arguments, it is the Examiner's position that the claims are now rejected under 35 USC 103 over the prior art of Watanabe et al. While Watanabe et al. does not specifically teach immersing its steering wheel workpiece in the transfer liquid to a depth of half its diameter, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art to have determined the optimum depth of immersion through routine experimentation, depending upon the amount of activator or adhesive used and therefore the amount of liquid pressure needed to adhere the transfer pattern, through routine experimentation in the absence of a showing of criticality.

### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford whose telephone number is 703-306-5461.

The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kac

June 25, 2002



SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700